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EXAMINER

WANG, SHENGJUN

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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

9
10 Ex parte MASAO INOUE, MASAO OGAWA and
11 HIROSHI NAKAMURA
12

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14 Appeal 2007-3263
15 Application 08/987,380
16 Technology Center 1600
17

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19 Oral Hearing Held: November 13, 2007
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23 Before ERIC B. GRIMES, LORA M. GREEN, and NANCY J. LINCK,
24 *Administrative Patent Judges*.
25

26
27 ON BEHALF OF THE APPELLANTS:
28

29 JOHN CALLAHANN, ATTORNEY
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36 The above-entitled matter came on for hearing on Tuesday,
37 November 13, 2007, at The U.S. Patent and Trademark Office, 600 Dulany
38 Street, Alexandria, Virginia, before Timothy J. Atkinson, Jr., Reporter.

1 MS. COOK: We have before us Calendar Number 22, Appeal
2 Number 2007-3263, attorney John Callahann.

3 JUDGE GRIMES: Good Morning, Mr. Callahann.

4 MR. CALLAHANN: Good Morning.

5 JUDGE GRIMES: As you might know, you'll have 20 minutes
6 to make your argument. So, please make yourself comfortable and get
7 started whenever you're ready.

8 MR. CALLAHANN: Okay, great. Just quickly set up my file
9 and I'll be ready to start.

10 JUDGE GRIMES: Okay, whenever you're ready.

11 MR. CALLAHANN: Okay. Good morning. My name is John
12 Callahann and I'm here today in connection with the appeal for U.S.
13 Application Serial Number 08/987380. And I believe that the Board needs
14 to consider primarily three issues in connection with this appeal.

15 First, of course, the law applicable to the case has changed.
16 This application went up on appeal in a pre-KSR error and we argued on our
17 brief appropriately that there was no -- primarily that there was no
18 motivation in the references to arrive at the claimed invention. In addition
19 to, there is evidence of un-obviousness. The Appeal is now being
20 considered in a post-KSR era, so we believe that there are differences, of
21 course, between the law. The KSR case said that the TSM analysis was too
22 rigid, but we believe that the outcome should be the same; that the
23 Examiner's prima facie case of obviousness is improper.

24 The second issue that we believe the Board needs to consider is,
25 I've mentioned it already, the fact that there is no prima facie obviousness
26 case made by the Examiner. The Examiner, of course, has the burden to

1 make the prima facie obviousness case. We believe that he has not done that
2 in this, in this prosecution of this application.

3 And, the third issue that the Board needs to consider is the fact
4 that we have presented evidence of un-obviousness; that the Examiner, I
5 believe, is improperly criticized. We do not admit that the Examiner has
6 made a prima facie obviousness rejection, but we believe in any event that's
7 been overcome by the declaration that we've submitted during the
8 prosecution. So, I believe that those are primarily the three issues that the
9 Board needs to consider. So, let me go back to each of them in turn.

10 First of all with regard to the law of obviousness, we argue the
11 Appeal based upon there being a lack of motivation in the three references
12 that the Examiner cited. The primary reference is a reference by the name of
13 Tocker, T O C K E R, and the secondary references are Burger and Kogler,
14 K O G L E R. The claimed invention relates to a pesticide that's coated with
15 a polyurethane. The claims are a little bit -- are set up in a way that they
16 cover two different embodiments. We elected the embodiment that relates
17 to polyurethane. I believe the other embodiment relates to an epoxy coating.
18 But the invention relates to a pesticide that is coated with a polyurethane
19 where the isocyanate and the polyol components of the polyurethane are
20 applied to the pesticide together. Claim 1 is a composition, it refers to Claim
21 6, which is the method that requires that step. And of course there's other
22 elements of the claim, but that's essentially for purposes of this Appeal what
23 I think should be focused upon.

24 The primary reference that the Examiner used to reject the
25 claims is a reference by the name of Tocker, T O C K E R, and that
26 reference relates to so called interfacial polymerization. And what that

1 means in the context of this technology is, generally speaking, interfacial
2 polymerization is a low temperature polymerization technique whereby
3 polymerization of two reactants is carried out at the interface between two
4 phases; each containing one of the reactants. Technically speaking the
5 reactants diffuse to and undergo polymerization at the interface, and I'm
6 referring in that sense to the definition from Odian, which is principles of
7 polymerization. I don't believe that this is of record, but this is a well
8 known text book in the field of polymerization. But specifically what
9 Tocker teaches is including the polyol component of the polyurethane with
10 the pesticide and then adding the isocyanate. So, in a sense it's this
11 interfacial polymerization which is different from what were claiming in our
12 application. The Examiner recognizes that, and he relies on two secondary
13 references to teach or to show that the claimed invention would have been
14 obvious, but we would submit to the Board that that would not be
15 appropriate. The rejection would, in essence, destroy the teachings of the
16 primary reference.

17 The primary reference, Tocker, clearly states that its invention
18 relates to this interfacial polymerization, and I'm referring to Page 2 of the
19 Tocker reference at lines approximately 26. But, it states that the invention
20 relates to a process for preparing controlled release granules of pesticides for
21 direct application consisting essentially of over coating a granular carrier
22 containing a pesticide and a polyhydroxylated compound, which would be
23 the polyol or water with a liquid polyisocyanate and a polymerization
24 catalyst optionally at elevated temperatures resulting in interfacial
25 polymerization to a solid cross-linked polyurethane or polyurene barrier. So
26 the primary reference is clear about the specific polymerization technique

1 that it's using. So in our view it would be, in essence, destroying the, the
2 essential teachings of the primary reference to make the substitution that the
3 Examiner is suggesting. He's suggesting that you, in essence, eviscerate the
4 whole teaching of the primary reference and substitute teachings of the
5 secondary references which show that the two components of the
6 polyurethane can be added at the same time.

7 JUDGE GRIMES: But if the point of both sets of references is
8 to coat something with polyurethane, then I'm having a hard time seeing
9 what the big difference would be if in both cases you end up with
10 polyurethane coat on a granule of something.

11 MR. CALLAHANN: Well in the invention we coat the
12 pesticide or we add the pesticide -- we add to the pesticide, excuse me, the
13 two components of the polyurethane. The rejection is set up in such a way
14 that the primary reference teaches this interfacial polymerization where you
15 have the pesticide with one component with polyurethane and then you add
16 the second component with polyurethane. So, I see what you're saying, but
17 in terms of the analysis of obviousness in the case, you have to start with the
18 primary reference and what the primary reference teaches. And, then
19 determine whether it would have been obvious to a person with ordinary
20 skill in the art to modify the primary reference in view of the teachings of
21 the secondary reference. So if that's the way -- or else we're comparing the
22 claimed invention to the claimed invention in a sense that the claimed
23 invention requires adding the two components of the polyurethane to the
24 pesticide and I believe you're saying, well, look at the references as a whole;
25 they do teach generally the same thing. But I, I think the obviousness
26 analysis should be a little bit sharper and more focused on the primary

1 reference and whether or not it would have been obvious to one skilled in
2 the art to modify the primary reference in view of the secondary references.
3 And we would submit that that's not the case because to do so would be to
4 essentially destroy the core or essential element of the primary reference.

5 JUDGE GREEN: What if reversed the rejection. You either
6 used Burger or Kogler as your primary reference because they teach a
7 polyurethane coated agri-chemical that's in a granule and you relied on
8 Tocker for teaching that you can get a pesticide as a granule that is coated
9 with, coated with polyurethane. You think the same analysis would fit?

10 MR. CALLAHANN: Well, that is a different rejection.

11 JUDGE GREEN: I understand that, but I mean this is still the
12 same set of references so I guess when, when you consider the references as
13 a whole --

14 MR. CALLAHANN: Well, I don't want to sidestep your
15 question, but the Appeal today is the rejection of Tocker in view of the two
16 secondary references. I don't know why the Examiner didn't make the
17 rejection that I think you're, you're, you're perhaps proposing. I don't
18 know, that would be a different issue and a different analysis, you know.
19 Obviousness is a mixture of law and fact. It's a legal conclusion based upon
20 factual underpinnings. So I would have to study that combination very
21 carefully and, and analyze whether it would have been an obvious to modify
22 one or more of the secondary references in view of the primary reference,
23 which I think is what you're proposing. But you have to start somewhere in
24 terms of the obviousness analysis. Whether it's as in this appeal; the
25 rejection of Tocker in view of Burger and Kogler or perhaps a different
26 rejection such as Burger or Kogler in view of Tocker. But I haven't

1 analyzed that rejection because it wasn't up on appeal.

2 JUDGE LINCK: With respect to the other rejection that is
3 before us, what specific claim language are you focusing on?

4 MR. CALLAHANN: Yes, yes. First of all, Claim 1 is the
5 granular pesticidal composition that refers to when the embodiment is the
6 polyurethane resin; Claim 6. Claim 6 is the method for manufacturing a
7 granular pesticidal composition coated with a polyurethane resin comprising
8 the steps of -- two steps; Step A is adding a mixture containing 0.05 to 1.5
9 parts by weight of three alternatives: one, two and three. I'll just focus on
10 the first one. Polyisocyanate having a tri or higher isocyanate groups and
11 polyol. So it would be the step of adding a mixture containing between 0.05
12 to 1.5 parts by weight of this isocyanate and polyol to the pesticidal active
13 ingredient containing granule to be coated, and that's towards the bottom of
14 Claim 6. And then B is repeating Step A. So, that step would be our
15 position requires the addition of the isocyanate and the polyol together to the
16 pesticide.

17 JUDGE LINCK: At the same time?

18 MR. CALLAHANN: That's right. So, I believe I covered the
19 two points that -- the first two points that I believe the Board needs to
20 consider the fact that the law has changed, but I think the outcome should
21 still be the same. The second which is we believe that the Examiner has not
22 made a prima facie obviousness rejection. Specifically, that he's not carried
23 his burden to set forth a reasonable rationale as to why the claimed invention
24 would have been obvious based upon the references he's relied upon.

25 The third issue that I believe the Board needs to consider is the
26 evidence of nonobviousness that the Applicant submitted. As I've

1 mentioned, we don't agree that the Examiner has made a prima facie
2 obviousness rejection. But in any event, we believe that the declaration that
3 was submitted with, I believe, an RCE during the prosecution shows an
4 unpredictable result for the claimed invention. Specifically a -- and a greatly
5 extended controlled release of the pesticide as compared to the embodiment
6 that is in -- that does correspond to the primary reference. And again, I think
7 that that's the proper analysis because I think the Examiner got off track on
8 that part of the prosecution too. We submitted the declaration. There was a
9 comparison between the claimed invention and the closest prior art, which
10 the Examiner has identified as the Tocker reference. So the claimed
11 invention again would be the addition of the two components of the
12 polyurethanes; the pesticide at the same time versus the addition of the
13 isocyanate to the pesticide containing the polyol. That was the direct
14 comparison in the declaration that was submitted and we were able to show
15 that there is a greatly extended, I believe at least three times extended,
16 controlled release of the pesticide. The Examiner didn't dispute that, but he
17 criticized the declaration on the basis that it was not the correct comparison.
18 In the Examiner's view the declaration should have compared the claimed
19 invention to the combination of the references, but I would submit to the
20 Board that that's not the proper analysis. I believe that that is clear from the
21 case law and also the MPEP. Because that would be, in essence, comparing
22 the claimed invention to the claimed invention. So again in terms of the
23 obviousness analysis and also the analysis of the evidence of obviousness.
24 You have to start somewhere, of course. And I believe that the Applicants
25 correctly started with the primary reference; Tocker reference and compared
26 the claimed invention to the Tocker reference and showed an unexpected

1 result. And that's --

2 JUDGE GREEN: I'm sorry. Would you agree that both of the
3 secondary references, which I understand that you don't agree with the
4 combination, that they discuss that you can change the amount of controlled
5 release that you get depending on how much coating you put on the particle
6 and specifically pointing to Figure 3 of Burger, and I have the Canadian one,
7 it says on Line 3 that you can get a controlled release that is similar to your
8 controlled release using their coating method?

9 MR. CALLAHANN: Again, it's, it's not that I disagree with
10 the rejection, it's just that the Examiner hasn't made it. But, you're correct.
11 There is data in the Canadian -- I'll call it the Canadian Patent -- Canadian
12 reference, that would have to be considered if that type of rejection was
13 made. So, I'd like to point out just one other point in connection with the
14 declaration. That is in line with all the guidelines that the Patent Office has
15 put forth. Nearly every guideline that the Patent Office had set out in
16 connection with the KSR case relates to -- or refers to predictability or a
17 predictable result. So the declaration shows, I would submit, an
18 unpredictable result for the claimed invention. Now in summary, the
19 Applicants would submit that there's no reason to modify Tocker as alleged
20 by the Examiner. And the Examiner's rejection would eliminate the
21 essential element of Tocker which is the interfacial polymerization and
22 substitutes teachings from the secondary reference. So, it would not be
23 obvious and not common sense to destroy the teachings of the primary
24 reference. Thank you. I'd be happy to answer any questions.

25 JUDGE GRIMES: No more questions. Thank you.

26 MR. CALLAHANN: Thank you.

Appeal 2007-3263
Application 08/987,380

- 1 (Whereupon, the proceedings concluded.)
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